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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,766	05/24/2000	Robert W. Cain	2961R-01	8090

7590 02/27/2002

THE LUBRIZOL CORPORATION
Patent Dept. - Patent Administrator
29400 Lakeland Boulevard
Wickliffe, OH 44092-2298

EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 02/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/577,766	Applicant(s) CAIN, ROBERT W.	
	Examiner Ellen M McAvoy	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-27 are still rejected under 35 U.S.C. 103(a) as being unpatentable over Ozbalik et al (6,034,040).

Applicant's arguments filed 2 January 2002 have been fully considered but they are not persuasive. As set forth in the previous office action, Ozbalik et al ["Ozbalik"] disclose lubricating oil compositions useful as manual transmission and axle lubricants which comprise a mineral oil having a) a Viscosity Index (VI) of greater than 110 and an aniline point of greater than 110°C and b) a linear and single ring paraffin content (saturates) of *greater* than 68 wt. %. Ozbalik does not set forth an upper limit for the paraffin content. And, as argued by applicant, Ozbalik fails to teach the aliphatic or linear saturate content and the alicyclic or single ring saturate content separately. However, the examiner is of the position that the instant claims which comprise "at least 45% by weight of aliphatic saturates" fail to patentably distinguish over the prior art which comprises "a linear + single ring paraffin content of 68% or greater". The lubricating oil compositions of Ozbalik having such a high saturate content are taught to have "excellent thermal and oxidative stability"; applicant argues that the "mineral oils having a higher proportion of aliphatic saturates have better oxidation properties and low temperature properties". The examiner is of the position that without test data demonstrating applicants

“better oxidation properties and low temperature properties” over the closest prior art of Ozbalik, the claims fail to patentably distinguish over Ozbalik. As also previously set forth, the composition also comprises from about 0.1 to 40 weight percent of at least one polymer selected from the group consisting of olefin (co)polymer, polyalkyl(meth)acrylate(s) and mixtures thereof; and from 2 to 25 weight percent of a detergent/inhibitor package containing one or more conventional additives. See column 1, line 60 to column 3, line 22. The VI is preferably between 110 and 135. See col. 2, lines 25-30. The polymer component may comprise mixtures of (b') at least one olefin copolymer with a number average molecular weight of from about 1,000 to about 10,000, and (b'') a polyalkyl (meth)acrylate having a number average molecular weight of from 10,000 to 250,000; in a ratio of (b'):(b'') of from 20:1 to 1:2. See column 2, lines 46-67. The olefin copolymer component may be present in the oil composition in an amount of up to 40 percent by weight. See column 9, lines 57-65. The detergent/inhibitor package useful in Ozbalik may contain one or more conventional additives such as dispersants, antioxidants, extreme pressure additives, and anti-wear additives. Suitable extreme pressure additives include dihydrocarbyl polysulfides, sulfurized olefins and phosphorus-containing additives. See column 8, lines 27-64. Thus, the examiner maintains the position that Ozbalik meets the limitations of the claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

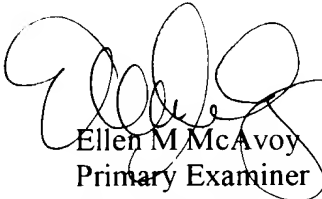
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode can be reached on (703) 308-4311. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
February 26, 2002